

REMARKS

These amendments and remarks are filed in response to the Office Action mailed December 2, 2008. For the following reasons, this application should be allowed and the application passed to issue. No new matter is introduced by this amendment. The amendment to claim 9 is supported by claim 6. Claims 2-4 and 8 are amended to depend from claim 6. Claim 6 is amended to further clarify it.

Claims 2-4, 6, 7, and 9 are pending in this application. Claims 1-4 and 6-9 have been rejected. Claims 2-4, 6, 7, and 9 are amended in this response. Claims 1 and 8 have been canceled in this response. Claims 5 and 10-12 were previously canceled.

Claim Rejections Under 35 U.S.C. § 103

Claims 1-4 and 7-9 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Tarui et al. (JP 2003/077529) in view of Yamamoto et al. (US 2003/0054249). The Examiner asserted that Tarui et al. disclose a lithium secondary battery using a negative electrode active material comprising an alloy mainly containing Si and an element selected from the group consisting of Ti, Co, Mg, Zr, V, Mo, W, Mn, and Fe. In the Response to Arguments section, the Examiner averred that our arguments that the oxide layer of Yamamoto et al. would eliminate the beneficial effects achieved by Tarui et al. was an opinion unsupported by evidence.

Claims 1-4 and 7-9 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Ohshita et al. (US 2004/0023111) in view of Yamamoto et al. The Examiner maintained that Ohshita et al. disclose a lithium secondary battery using a negative electrode, wherein the negative electrode comprises a silicon-cobalt alloy.

These rejections are traversed, and reconsideration and withdrawal thereof respectfully requested.

Claims 1 and 8 have been canceled, thus, the rejection of these claims is moot. The combinations of Tarui et al. or Ohshita et al. and Yamamoto et al. do not suggest the claimed negative electrode active material and non-aqueous electrolyte rechargeable battery. Claim 6 was not rejected by the combinations of Tarui et al. or Ohshita et al. and Yamamoto et al. Dependent claims 2-4, 7 and 7 have been amended to depend from claim 6, and are thus, allowable for at least the same reasons as claim 6. Claim 9 has been amended in a corresponding manner as claim 6, and is thus allowable, as the cited references do not suggest an inner layer comprising a Si phase and an alloy phase containing Si and at least one element selected from the group consisting of Ti, Co, Mg, Zr, V, Mo, W, Mn and Fe; and a surface layer comprising silicon oxide of 0.2 to 1,000 nm in average thickness formed on the inner layer, wherein the active material is mainly composed of Si, as required by claim 9.

Claims 1-4, 6, 7, and 9 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Fukui et al. (US 2004/0062991) in view of Yamamoto et al. The Examiner maintained that Fukui et al. disclose a lithium secondary battery using a negative electrode, wherein the negative electrode comprises a silicon alloy prepared by liquid quenching and gas atomizing. The Examiner relied on Yamamoto et al. to teach the claimed silicon oxide surface layer and asserted that it would have been obvious to combine Yamamoto et al. with Fukui et al. in order to reduce anode potential during discharging and to reduce HF acid level in the electrolyte.

The combination of Fukui et al. and Yamamoto et al. do not suggest the negative electrode active material for a non-aqueous electrolyte rechargeable battery, as required by claim 6, and the non-aqueous electrolyte rechargeable battery according to claim 9 because Fukui et al. is not prior art to the present invention. A certified English translation of the instant Japanese Priority document No. 2003-0099523 was filed April 5, 2007 in this application. The filing date

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of JP 2003-0099523 is April 2, 2003, which precedes the September 30, 2003 U.S. filing date of Fukui et al.

The dependent claims are allowable for at least the same reasons as the respective independent claims from which they depend, and further distinguish the claimed negative electrode active material.

In view of the above remarks, Applicants submit that this case should be allowed and passed to issue. If there are any questions regarding this response or the application in general, a telephone call to the undersigned would be appreciated to expedite the prosecution of the application.

To the extent necessary, a petition for an extension of time under 37 C.F.R. § 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 500417 and please credit any excess fees to such deposit account.

Respectfully submitted,

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